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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,853	07/24/2001	Susumu Kobayashi	2001_1035A	4034
513 7590 06/06/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
TANG, KAREN C				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/910,853

Applicant(s)

KOBAYASHI ET AL.

Examiner

KAREN C. TANG

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 24, 28, 32, 36, 39, 43, 47, 50, 54 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 24, 28, 32, 36, 39, 43, 47, 50, 54 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/08 has been entered.
- Claims 1-20, 24, 28, 32, 36, 39, 43, 47, 50, 54, and 58 are presented for further examination.

Response to Arguments

Applicant's arguments filed 10/2/07 have been fully considered but they are not persuasive.

Applicant argued that the prior arts of records do not disclose the newly amended limitation:

Wherein said mail terminal comprises:

“a selection received unit operable to, based on the received identifier list, display item indicating the unique identifiers in a selectable manner;”

Examiner disagrees.

Hanna, with suggestions of AAPA and Pollack, teaches the alleged missing limitation, where Hanna's mail terminal comprises the selection received unit, which, based on the received identifier list, display item (URL) indicating the unique identifiers in a selectable manner (the

URL as an item that comprises the unique identifier, the user can select the URL in order to retrieve the attachment, refer to Col 5, Lines 55-60).

Applicant intended to explain the present invention during the arguments/remark filed on 2/22/08, such that AAPA, the cited art of records, does not disclose: "a construction unit operable to construct a file attached e-mail by attaching the at least one attached file acquired by said attached file acquisition unit to the attached-file specifying e-mail received by said reception unit"

Examiner disagrees.

Limitations such as "a construction unit operable to construct a file attached e-mail by attaching the at least one attached file acquired by said attached file acquisition unit to the attached-file specifying e-mail received by said reception unit" is still able to read on by the cited art of records AAPA (argument/remarks, filed on 10/7/05, page 26), where the gateway must construct a file attached email in order for user to retrieve the mail attachments.

Applicant argues that AAPA fails to disclose or suggest a situation where multiple files have been attached to one e-mail.

Examiner disagrees.

According to the claim language, it does not limit the environment where there are multiple files been attached to one e-mails. Therefore, the prior art still reads on the limitations.

Applicant argues that there is no disclosure or suggestion of a situation where an identifier is associated with each attached file.

Examiner disagrees. According to the AAPA, the attached file is associated with an identifier/mail ID (refer to Page 26, Lines 18-19).

According to applicant's own specification (US 2002/0010748 par 0102) where applicant stated that the format of attached ID corresponds to the message ID, in another words, the mail ID is the identifier, so the gateway comprise unit/module that is capable of extract the mail and mail attachment and then assigned the mail ID as a reference to the attachment (refer to argument/remarks, filed on 10/7/05, page 26), which is taught by AAPA.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20, 24, 28, 32, 36, 39, 43, 47, 50, 54, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admit Prior Art (AAPA : remarks/arguments received on 10/07/05) in view of Hanna et al hereinafter Hanna (US 7,054,905) in further view of Pollack (US 6,505,236) and Prahlad et al hereinafter Prahlad (US 2007/0143431).

1. Referring to Claims 1, 5, 9, 13, 17, 20, 24, 28, 32, 36, 39, 43, 47, 50, 54, and 58, AAPA discloses an e-mail transmission/reception system including a mail terminal, a mail server, and a mail gateway, wherein said mail gateway is connected to the said mail terminal via a network and to said mail server via another network (pages 26, Lines 13 - 26), wherein said mail gateway comprises:
a list transmission unit operable to generate a list of identifiers (a list is an single element: a mail ID is a list) generated by the said identifier generation (it is the system comprises a identifier

generation unit in able to create mail id) and transmit the identifier list to said mail terminal (page 26, Lines 13-26);

a reception unit operable to receive attached-file specifying e-mail transmitted from said mail terminal (email that comprising an attached file received from terminal, page 26, Lines 13-26), the attached-file specifying e-mail including one or more identifiers generated by said identifier generation unit (page 26, Lines 18-26);

an attached file acquisition unit operable to acquire attached files from the-said attached file holding unit, the at least one attached file corresponding to the at least one identifier included in the attached-file specifying e-mail received by said reception unit (page 26, Lines 18-26);

a construction unit operable to construct a file attached e-mail by attaching the at least attached files acquired by the-said attached file acquisition unit to the attached-file specifying e-mail received by said reception unit (page 26, Lines 19-23);

and a mail transmission unit operable to transmit the file attached e-mail constructed by said construction unit to said mail server (page 26, Lines 19-23); and

wherein said mail terminal comprises:

a list reception unit operable to receive the identifier list from said mail gateway (that the terminal is able to received email with attachments, page 26, Lines 13-27);

a preparation unit operable to prepare the attached file specifying email including an unique identifier corresponding to an item (when selected all the attachments, it is equivalent to the conventional ways) as a substitutes for at least one attached file that the user wants to attach to the file attached e-mail (page 26, Lines 13-27); and

a transmission unit operable to transmit the prepared attached-file specifying email to said mail gateway (page 25, Lines 23-26).

Although AAPA disclosed the invention substantially as claimed, AAPA is silent in regard to indicate server comprising an attached file holding unit operable to receive an e-mail addressed to a user who possesses said mail terminal and hold one or more attached files included in the e-mail;

and a mail distribution unit operable to receive a file attached e-mail transmitted from said mail gateway and distribute the file attached e-mail to a respective address of one or more receivers of the e-mail;

and a selection receiving unit operable to, based on the received identifier list, display items indicating the unique identifiers in a selectable manner;

Hanna, in an analogous art, disclosed an attached file holding unit operable to receive an e-mail addressed to a user who possesses said mail terminal and hold one or more attached files included in the e-mail (refer to Col 1, Lines 50-55);

and a mail distribution unit operable to receive a file attached e-mail transmitted from said mail gateway and distribute the file attached e-mail to a respective address of one or more receivers of the e-mail (refer to Col 3, Lines 60-67, Col 4, Lines 1-15); and

a selection receiving unit operable to, based on the received identifier list, display items indicating the unique identifiers in a selectable manner (refer to Col 5, Lines 55-60, the unique identifier must be displayed to the user in order for the selection and retrieve manner);

Hence, providing the feature disclosed by Hanna, would be desired for user to utilize it in the gateway system in order for the system maintain the stabilities and avoid latency by taking off loads from the server.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of AAPA by including the features in Hanna.

The suggestion/motivation for doing so would have been that by eliminate the need for individual decision and input by the user, stimulating the operating time and allow system to eliminate unnecessary space being allocated.

Although AAPA and Hanna disclosed the invention substantially as claimed, AAPA is silent in regard to comprising an identifier generation unit operable to generate an unique identifier for each attached files held by said attached file holding unit, respectively;

Pollack, an analogous art disclosed an identifier generation unit (producing calls) operable to generate an unique identifier for each attached files held by said attached file holding unit, respectively (refer to abstract);

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine AAPA, Hanna, and Pollack, because it would have been desirable to avoid significant amount of effort to manually copy the file to the server and used up unnecessary system resources.

The suggestion/motivation would have been that by managing the stored file, it allows user to quickly and easily manage the files on a network storage system on any device (supported by Prahlad, refer to 0024).

Although AAPA and Hanna combined suggested the invention substantially as claimed, both AAPA and Hanna are silent in regarding to disclosed the attached-file specifying e-mail including at least one identifier among the unique identifiers generated by said identifier generation unit for each of the plurality of attached files held by said attached file holding unit; Pollack, however, also in an analogous art, disclosed the attached-file specifying e-mail including at least one identifier (file handler, abstract) among the unique identifiers generated by said identifier generation unit for each of the plurality of attached files held by said attached file holding unit (refer to abstract);

Hence, providing the feature suggested by Pollack, it would be desired for user to have a generator that generate the unique identifier for the attachment files, for user to identify the file that is desired to forward or attached. Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine AAPA, Hanna, and Pollack by including the feature suggested in Pollack.

The suggestion/motivation would have been that by managing the stored file, it allows user to quickly and easily manage the files on a network storage system on any device (supported by Prahlad, refer to 0024).

2. Referring to Claims 2, 6, 10, and 14, AAPA discloses wherein said attached file holding unit is operable to, whenever receiving an e-mail that includes attached files, generate a list of the attached files and pass the list of the attached files to said identifier generation unit (page 26); and said identifier generation unit is operable to generate an identifier for each of the attached

files, respectively, in accordance with the list of the attached files passed by said attached file holding unit (page 26).

3. Referring to Claims 3, 7, 11, 15, and 18, AAPA discloses wherein said mail terminal further comprises: a file format registration unit operable to register one or more file formats of attached files for each receiver's address that the receiver should adopt in said mail gateway (attachment is inherent comprises a type of file format, page 26); wherein said mail gateway further comprises: a file format storage unit operable to store receivers' addresses and file formats that are registered by said file format registration unit (page 26); and a file format conversion unit operable to convert a file format of each attached file for each receiver's address in accordance with the receivers' addresses and the file formats that are stored in the said format storage unit (page 26); and wherein said construction unit is operable to construct the file attached e- mail by attaching each attached files converted by said file format conversion unit from and as a substitute for each attached file acquired by said attached file acquisition unit, respectively (substitute the file attachment with mail ID, page 26).

4. Referring to Claims 4, 8, 12, 16, and 19, AAPA discloses all the limitation in Claim 1, furthermore, AAPA discloses wherein said mail terminal further comprises: a sharing notification unit operable to notify said mail gateway that one or more attached files included in

an e-mail addressed to the user of said mail terminal are to be shared with other users (send email to the destination, refer to page 26);

wherein said mail gateway further comprises:

an attached file sharing unit operable to, when receiving the notification that the one or more attached files are to be shared with the other users from said mail terminal share each of the attached files held by said attached tile holding unit with the other users (refer to page 26);

wherein said sharing notification unit includes:

a shared file notification unit operable to notify said mail gateway of one or more identifiers (each attachment does has unique ids) selected by the user from the identifier list as substitutes for the one or more attached files that are permitted to be shared (page 26);

and a sharer notification unit operable to notify said mail gateway of one or more sharers of each of the attached files that are to be shared with the other users (page 26);

wherein said attached file sharing unit is operable to share attached files that correspond to the identifiers notified from said shared file notification unit among attached files held by the-said attached file holding unit with the sharers notified from said sharer notification unit (page 26);

wherein said list transmission unit is further operable to transmit a list of the shared identifiers to the sharers of the attached files wherein said attached file acquisition unit further operable to acquire attached files that correspond to the shared identifiers and wherein said list reception unit further operable to receive a list of shared identifiers that have one to one correspondence to each of the attached files that are shared by the user of said mail terminal as one member of the sharers (page 26).

AAPA, nor Hanna expressly comprising an identifier generation unit operable to generate an unique identifier for each attached files held by said attached file holding unit, respectively; Pollack disclosed an identifier generation unit operable to generate an unique identifier for each attached files held by said attached file holding unit, respectively (refer to abstract); At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine AAPA, Hanna, and Pollack since the inventions are analogous. The suggestion/motivation would have been that by managing the stored file, it allows user to quickly and easily manage the files on a network storage system on any device (supported by Prahlad, refer to 0024).

Conclusion

Examiner's Notes: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/K. C. T./

Examiner, Art Unit 2151

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151

